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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,387	05/25/2000	Hidehiko Kando	29284/504	6130
7590	03/08/2004			EXAMINER PSITOS, ARISTOTELIS M
Edward W Greason Esq Kenyon & Kenyon One Broadway New York, NY 10004			ART UNIT 2653	PAPER NUMBER 8

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/578,387	KANDO ET AL.
	Examiner	Art Unit
	Aristotelis M Psitos	2653

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) all is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

Priority

Applicants' response of 12/11/03 has been considered with the following results.

Specification

The amended title of the invention is descriptive. The examiner appreciates applicants' cooperation in providing such.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps recited in method claims 1-4 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Response to Arguments

Applicant's arguments filed on 12/11/03 have been fully considered but they are not persuasive.

The examiner can find no such steps as claimed by the above-identified claims 1-4 and 9 depicted in any of the figures submitted. Hence the objection is repeated. Failure to comply with such a requirement is not an option.

Claim Objections

With respect to claim 1, the preamble designates this claim as "an information recording and reproducing method"; however, the examiner cannot readily ascertain any positive steps recited in the remainder of the positively recited steps in this claim that permit any recording.

^{3 - 4 are}
Claim 2 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In particular, claims 2,3 and 4 broaden the scope of the parent claim, i.e., the parent claim is drawn to a recording and reproducing method, while the dependent claims is drawn to a recording and

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reproducing method OR to a recording OR reproducing method. Appropriate correction is REQUIRED because under current USPTO practice dependent claims FURTHER LIMIT the parent claim and do not broaden the scope.

With respect to claim 5, this claim is drawn to an apparatus paralleling the limitations of claim 1. However, there is no there is no positive RECORDING performed.

With respect to claim 9, this claim is drawn to an information method. At best this is drawn to a reproducing method and such needs to be identified, i.e., it is NOT A RECORDING METHOD.

Further elaboration is respectfully requested from applicants.

As far as the claims recite positive limitations and as interpreted by the examiner the following rejections are made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1,9,5 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gushima et al.

Gushima et al discloses in the optical recording and reproducing environment, both apparatus for and methods of recording and reproducing; wherein the disc has video and audio information recorded thereon in various zones/sections along the radial direction of the medium. The format is interpreted by the examiner as defining DVD recording. As is known, DVD recording takes advantage of the wobble information providing for timing/addressing abilities. Hence the examiner concludes that the claimed wobbling or deforming step is inherently present.

If applicants' can convince the examiner that such is not the case, then under 103 considerations, the examiner would rely upon Takagi et al which teaches/discloses such for DVD formatted signals.

It would have been obvious to modify the base system of Gushima et al with the well known use of wobbling signals in the dvd signal format, motivation is to use existing signal formats and hence provide for compatibility upon recording or playback i.e., not requiring the manufacturing of systems components – hardware not using such techniques and hence not being able to play such discs upon the existing dvd players already in the public domain.

With respect to the claimed clock signal limitation, the examiner points applicants' attention to figures 11 and 12 in which the examiner interprets the "sync" as the clock signal.

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With respect to the newly inserted/amended detection of the pre-recorded information, the examiner interprets such as the block/zone/section identification found in the address information – see col. 7 lines 15-18 and col. 13 lines 45-61.

With respect to the ultimate paragraph in claims 1 and 9, applicants' attention is drawn to col. 11 line 34 to col. 12 line 6, and to col. 14 line 54 – to col. 15 line 3. The examiner concludes that the conversion predicated upon the claimed signals is present and furthermore, that the "multiplication" is also present as stated in col. 14 lines 60-63.

With respect to claims 5 and 10, these are the apparatus claims analogous to the above method claims. The apparatus elements are found in the Gushima et al reference – see figure 6. With respect to the claimed frequency changer circuit, the examiner interprets the rate transfer unit 47 as such, i.e., inherently present.

Alternatively, if applicants' can convince the examiner that such does not meet the claimed frequency changer circuit then under further 103 considerations, the examiner can also rely upon the multiplier circuitry depicted in the references to either JP WO98/43241 or EPO 0800276 as indicated in the previous OA.

It would have been obvious to modify the base system of Gushima et al with the above frequency changer circuitry taught in either of the secondary references, motivation is to use established circuit components for the rate transfer unit of Gushima et al and hence no need to recreate a rate transfer unit from scratch – i.e., save time for instance in not needing to recreate such a device.

Response to Arguments

Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

2. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 above, and further in view of DVD-RAM art.

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As acknowledged by applicant DVD-RAM formats exist. Such formats have appropriate buffer regions before and after the data regions. As the zonal factor varies, increases, since the linear data density is kept constant, the buffer area size increases as recited.

With respect to claim 4, the examiner interprets the claim to mean that as the buffer size area diminishes in size, there is now information recorded therein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Hard copies of the application files are now separated from this examining corps; hence the examiner can answer no questions that require a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP